

REMARKS

Applicants have carefully considered the January 9, 2008 Office Action, and the amendments above together with the comments that follow are presented in a bona fide effort to address all issues raised in that Action and thereby place this case in condition for allowance. Claims 1-19 were pending in this application. Claims 8-19 have been withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b).

In response to the Office Action dated January 9, 2008, claim 1 has been amended. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, in the written description of the specification, including the descriptions in Figs. 4, 5 and 6(b); and the specification at page 26, lines 4 to 11 and page 27, line 18 to page 29, line 4. Applicants submit that the present Amendment does not generate any new matter issue. Entry of the present Amendment is respectfully solicited. It is believed that this response places this case in condition for allowance. Hence, prompt favorable reconsideration of this case is solicited.

Claims 1-3 and 20 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Sun et al. (U.S. Patent No. 5,861,019, hereinafter "Sun"). Applicants traverse.

Applicant stresses that the factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir. 2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). There are significant differences between the claimed

inventions and the invention disclosed by Sun that would preclude the factual determination that Sun identically describes the claimed subject matter within the meaning of 35 U.S.C. § 102.

Independent claim 1, as amended describes two ground conductor layers (a ground conductor layer of a first stacked-layered circuit board and a ground conductor layer of a second stacked-layered circuit board); a logic circuit is provided that analog-digital converts electrocardiogram data obtained from the electrocardiogram measurement device; the radio communication device is arranged on the side opposite to the one side of the second stacked-layered circuit board facing the first stacked-layered circuit board; the logic circuit is arranged between the first stacked-layered circuit board and the second stacked-layered circuit board; and the electrocardiogram measurement device is arranged on the side opposite to the one side of the first stacked-layered circuit board facing the second stacked-layered circuit board.

Sun discloses that a radio communication device and an ECG measurement device are arranged with a ground conductor layer interposed therebetween, but fails to disclose or remotely suggest the arrangement of a ND converter. The present claimed subject matter includes a logic circuit that analog-digital converts electrocardiogram data, wherein the logic circuit is arranged between one side of the first stacked-layered circuit board and one side of the second stacked-layered circuit board. Accordingly, the present claimed subject matter is different from the disclosure of Sun.

The above argued difference between the claimed device and the applied art undermines the factual determination that Sun discloses the portable electrocardiograph identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 U.S.P.Q. 86 (Fed. Cir. 1986). Applicant, therefore, submits

that the imposed rejection under 35 U.S.C. § 102 for lack of novelty as evidenced by Sun is not factually viable and, hence, solicit withdrawal thereof.

Dependent claims 4-7 have been rejected under 35 U.S.C. § 103 as being unpatentable over Sun. Applicant respectfully traverses.

Dependent claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Sun in view of Quy (U.S. Pat. No. 6,602,191, hereinafter "Quy"). Applicant respectfully traverses.

Applicant incorporates herein the arguments previously advanced in traversal of the rejection under 35 U.S.C. § 102 predicated upon Sun. Dependent claims 4-7 and 21 are free from the applied art in view of their dependency from independent claim 1.

Claims 1-7 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Besson et al. (U.S. Pat. No. 6,289,238, hereinafter "Besson") in view of Shankar et al. (U.S. Pat. No. 7,225,029, hereinafter "Shankar"). Applicant traverses.

The Examiner asserted that Besson teaches the limitations of independent claim 1, but for an electrocardiogram measurement device arranged on one side of the stacked-layered circuit board and a radio communication device arranged on the other side of the stacked-layered circuit board. The Examiner asserted that Shankar discloses this structural separation and that it would have been obvious to combine the references in order to provide the "predictable result" of avoiding interference between the high-frequency communications circuitry and the sensitive electrogram circuitry.

Besson describes that a sensor is arranged on the skin side (a first layer), and a control unit 33 and a radio communication device (a transmitting circuit (31) and a receiving circuit (30)) are arranged on the back side of the sensor (a second layer). The ND converter that

converts a signal transmitted from the sensor into a digital signal (corresponding to the logic circuit of the present invention) is arranged in the transmitting circuit (31). That is, Besson does include the logic circuit that analog-digital converts electrocardiogram data, but does **not** describe that a ground conductor layer is arranged between the first layer and the second layer, as required in amended claim 1. Thus, Besson fails to include the feature of the present claimed subject matter, namely that “said logic circuit is arranged between one side of said first stacked-layered circuit board and one side of said second stacked-layered circuit board, and said radio communication device is arranged on the other side of said second stacked-layered circuit board.”

Moreover, Shankar describes that a chamber for a radio communication device and a chamber for a main circuit (including an electrocardiogram measurement circuit) are prepared, and that these chambers are partitioned by a ground conductor layer 690, for the purpose of preventing a communication circuit (radio communication device) from interfering with the electrocardiogram circuit. Furthermore, although the chamber for the main circuit includes a ND conversion circuit, the ground conductor layer merely separates the communication circuit and the other main circuits, but does **not** further divide the ND conversion circuit and the electrocardiogram measurement device. Thus, Shankar fails to include the structure of the present claimed subject matter, namely that “said logic circuit is arranged between one side of said first stacked-layered circuit board and one side of said second stacked-layered circuit board, said electrocardiogram measurement device is arranged on the other side of said first stacked-layered circuit board, and said radio communication device is arranged on the other side of said second stacked-layered circuit board.”

Thus, even if Besson and Shankar are combined as suggested by the Examiner, and Applicants do not agree that the requisite realistic motivation has been established, the present claimed subject matter will not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988). Accordingly, reconsideration and withdrawal of the rejection are solicited.

Dependent claims 6-7 have been rejected under 35 U.S.C. § 103 as being unpatentable over Besson in view of Shankar. Applicant traverses.

Dependent claim 21 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Besson in view of Shankar and further in view of Quy (U.S. Pat. No. 6,602,191, hereinafter "Quy"). Applicant traverses.

Applicant incorporates herein the arguments previously advanced in traversal of the rejection under 35 U.S.C. § 103 predicated upon Besson in view of Shankar. Dependent claims 6-7 and 21 are free from the applied art in view of their dependency from independent claim 1. The remaining reference to Quy fails to remedy the deficiencies of Besson and Shankar.

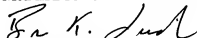
Accordingly, it is believed that all pending claims are now in condition for allowance. Applicant therefore respectfully requests an early and favorable reconsideration and allowance of this application. If there are any outstanding issues which might be resolved by an interview or an Examiner's amendment, the Examiner is invited to call Applicant's representative at the telephone number shown below.

Application No.: 10/695,442

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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